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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,111	11/30/2001	Mark W. Hubbard	CA920000060US1	4393

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A. Bruce Clay
IBM Corporation T81/062
P.O. Box 12195
Research Triangle Park, NC 27709

EXAMINER

DURAN, ARTHUR D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,111

Applicant(s)

HUBBARD ET AL.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3622

DETAILED ACTION

1. Claims 1-55 have been examined.

Response to Amendment

2. The Amendment filed on 2/22/05 is sufficient to overcome the Gerace reference as a 35 USC 102 rejection.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/22/05 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 11-21, 23-33, 35-47, 49-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Culliss (6,078,916) in view of Dabney (6,643,663).

Claim 1, 13, 25, 39: Gerace discloses a system, method, medium, software product for presenting marketing content on a web page, the system comprising:

Art Unit: 3622

- (a) a marketing page element, said marketing page element providing storage for data items (Fig. 2; Fig. 3a);
- (b) a web page connected to said marketing page element for presenting said data items (Fig. 2; Fig. 3a); and
- (c) a marketing content selection system connected to said marketing page element, wherein said marketing content selection system is adapted to select said data items to be stored in said marketing page element (Fig. 2; Fig. 3a; col 5, lines 54-63; col 7, lines 24-37; col 5, lines 40-53; Fig. 4a; col 4, lines 23-29; col 16, lines 41-47; col 17, lines 1-5; col 4, lines 39-45; col 16, lines 55-67).

Additionally, Gerace discloses a marketing page element placed on the web page and that these components are for placing on a web page (col 1, lines 30-45; col 1, lines 60-65; col 6, lines 45-52; col 17, lines 60-67; col 20, lines 10-20; col 16, lines 36-55; col 14, lines 25-35; col 2, lines 24-30; col 4, lines 25-30;).

Gerace discloses design of a webpage and marketing strategy for determining marketing content (col 5, lines 19-24; col 20, lines 10-20; col 12, lines 21-56; col 18, lines 10-26).

Gerace discloses taking the information currently displayed on the web page into account (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5).

Additionally, Gerace discloses advertisements placed in a variety of locations including top, bottom, sides, beginning and end as disclosed above and in the Applicant's Amendment dated 2/22/05 on page 19.

Also, Gerace discloses that advertisements can be a form of agate information:

Art Unit: 3622

“(18) In accordance with another aspect of the present invention, there are Agate Objects for providing the agate information and a Sponsor Object. In a preferred embodiment, the agate information includes stock information, advertisements, sports statistics, weather reports and the like. With regard to stock information, an Agate Object routine receives stock data on line, parses the data and makes a value-added calculation. As a result, the stock information is made searchable by variables such as price-earnings ratio, and the like” (col 2, line 60-col 3, line 5).

Therefore, any of the functionality in Gerace concerning agata data can also apply to advertising data.

Also, Gerace discloses that agate information can be placed anywhere on the web page:

“(19) Display preferences include orientation, color scheme, screen quadrant/location and the like, indicated with respect to the category of information (col 6, lines 30-35);

(48) Also, categories that a user selects to view further which are not on his Home Page are added with three options: customize, remove from first page, or move to a user-specified xyz position” (col 11, lines 50-56).

Therefore, it would be obvious to Gerace that a marketing page element can be placed anywhere on the webpage.

Additionally, Cullis discloses that a marketing page element can be placed anywhere on the webpage:

“(69) In this manner, the purchase of an advertising banner, positioned anywhere on a web site or search page, will allow users to. . . and/or categories for the matched article which is associated (in any possible way) with the advertising banner” (col 17, line 65-col 18, line 3).

Art Unit: 3622

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's advertisements can be placed anywhere on the webpage. One would have been motivated to do this in order to provide further flexibility in the placement of the advertisement in a place of interest to the user.

Additionally, Dabney discloses that advertising data can be stored in the web page itself (Fig. 14, item 1430):

“(70) A template in the webpage 1410 includes the owner or publisher of the webpage 1410 in image 1420. Also included in the webpage 1410 is a variety of images 1430 containing, for instance, stories, particular views, and advertising” (col 14, lines 40-45; Fig. 14, item 1430).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Gerace's advertising content can be stored in the webpage. One would have been motivated to do this in order to present the content in a timely manner.

Claim 2, 14, 26, 40: Gerace, Cullis, Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and Gerace further discloses that said marketing page element comprises a plurality of marketing page element items, and wherein at least one data item stored in said marketing page element is connected to one of said plurality of marketing page element items (Fig. 4a; col 4, lines 23-29; col 16, lines 41-47; col 17, lines 1-5; col 16, lines 24-29).

Claim 3, 15, 27, 41: Gerace, Cullis, Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 2, 14, 26, 40, and Gerace further discloses that said web page comprises a plurality of web page elements,

Art Unit: 3622

wherein each of said web page elements is connected to a marketing page element item of said plurality of marketing page element items, and wherein each of said web page elements is used to present a data item connected to said marketing page element item (Fig. 3a; col 5, lines 54-63; col 7, lines 24-37).

Claim 4, 16, 28, 42: Gerace, Cullis, Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and Gerace further discloses that said marketing content selection system is adapted to determine data items for storage in said marketing page element in accordance with a marketing strategy (col 12, lines 21-42; col 13, lines 10-20).

Additionally, Gerace discloses utilizing if-then logic related to a marketing strategy:

“(97) If a sponsor recognizes that, for example, 25-35 year-old women tend to purchase frequently and respond to their still, forest green colored advertisements most often, program 31 allows sponsors to place that type of ad in front of the subject target market segment during a reporting cycle. Thus, program 31 enables updating of the Sponsor and Ad Objects 33 during a reporting cycle to accommodate the foregoing.

(98) With respect to reporting, if the reports of program 31 show that customers respond to still advertisements more often than moving ones, bright colors more often than darker ones, graphics rather than text, large text rather than small, detailed text or square advertisements rather than bar style ones, such is relayed to the sponsors/advertisers” (col 20, lines 10-25).

Claim 5, 17, 29, 43: Gerace, Cullis, Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 4, 16, 28, 42, and Gerace further discloses that the marketing content selection system determines data

Art Unit: 3622

items to be stored in said marketing page element based on information available to said marketing content selection system pertaining to the person viewing the web page (Fig. 3b; col 4, lines 20-35).

Additionally, Gerace further discloses taking the information currently displayed on the web page into account (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5).

Gerace further discloses determining marketing content based on a combination of information displayed on the webpage and information available pertaining to the person viewing the web page (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5; col 2, lines 30-35).

Claim 6, 18, 30, 44: Gerace, Cullis, Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and Gerace further discloses a marketing content retrieval system connected to said marketing page element, said marketing content retrieval system adapted to provide said data items to said marketing page element for storage in said marketing page element (Fig. 2; Fig. 3a; col 5, lines 54-63; col 7, lines 24-37).

Claim 7, 19, 31, 45: Gerace, Cullis, Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 6, 18, 30, 44, and Gerace further discloses that the marketing content retrieval system comprises a first source of data items, wherein data items are retrieved from said first source of data items for subsequent storage in said marketing page element, said first source of data items comprising at least one of the following: a database, a data stream, a storage device, a memory device (Fig. 2; Fig. 3a; col 3, lines 54-62; col 3, lines 39-42).

Art Unit: 3622

Claim 8, 20, 32, 46: Gerace, Cullis, Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 7, 19, 31, 45, and Gerace further discloses that each data item in said first source of data items comprises one of the following: text, an image, an audio file, a video file, a movie, a document, a hyperlink, an animation, an object capable of accepting input, an object capable of presenting output (col 1, lines 31-44).

Claim 9, 21, 33, 47: Gerace, Cullis, Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 8, 20, 32, 46, and Gerace further discloses that the marketing content retrieval system is further adapted to provide at least one data item to said marketing page element from a pre-determined second source of data items in the event that at least one data item to be stored in said marketing page element as determined by the marketing content selection system cannot be retrieved from the first source of data items (col 16, lines 55-67;).

Claim 11, 23, 35, 49: Gerace, Cullis, Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and Gerace further discloses that the marketing content selection system comprises at least one of the following components: a rules processing engine, a table, a collaborative filtering engine, a selection program (col 16, lines 37-48; col 3, lines 56-61).

Claim 12, 24, 36, 50: Gerace, Cullis, Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 3, 15, 27, 41, Gerace further discloses at least one of the following:

Art Unit: 3622

- (i) a first set of tools for making modifications to the manner in which the marketing content selection system determines the data items to be stored in said marketing page element, wherein the modifications can be effected without changing either the layout of said web page elements on said web page or said data items (col 11, lines 24-36; col 11, lines 45-56);
- (ii) a second set of tools for making modifications to said data items, wherein the modifications can be effected without changing either the layout of said web page elements on said web page or the manner in which the marketing content selection system determines the data items to be stored in said marketing page element (col 11, lines 50-55; col 20, lines 13-15; col 6, lines 31-35); and
- (iii) a third set of tools for making modifications to the layout of said web page elements on said web page, wherein the modifications can be effected without changing either said data items or the manner in which the marketing content selection system determines the data items to be stored in said marketing page element (col 6, lines 31-40; col 17, lines 1-5).

Claim 37: Gerace, Cullis, Dabney disclose the above. Gerace further discloses a computer program comprising computer program code means adapted to perform all the steps of claim 13 when said program is run on a computer (Fig. 1; col 3, lines 50-62).

Claim 38: Gerace, Cullis, Dabney disclose a computer program as claimed in claim 37, Gerace further discloses that embodied on a computer readable medium (col 3, lines 55-62).

Claim 51: Gerace, Cullis, Dabney disclose a computer program product comprising:
Gerace further discloses that
a computer-readable signal-bearing medium (col 16, lines 55-60; col 36, lines 49-58; col 3, lines 45-62);

Art Unit: 3622

means in said medium for accomplishing the method of any of claims 13 to 24.

Claim 52: Gerace, Cullis, Dabney disclose the product of claim 51, Gerace further discloses that said medium is a recordable data storage medium (col 3, lines 55-62).

Claim 53: Gerace, Cullis, Dabney disclose the product of claim 51.

Gerace does not explicitly disclose that said medium is a modulated carrier signal.

However, Gerace discloses the utilization of networks, the Internet, transmissions, satellite, radio, and FM radio (col 16, lines 55-60; col 36, lines 49-58; col 3, lines 45-62) and the display of information along with radio or television transmissions (col 36, lines 49-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's utilization of satellite and radio to Gerace's utilization of networks. One would have been motivated to do this in order to provide the flexibility of a wireless manner of data transmission.

Claim 54: Gerace, Cullis, Dabney disclose the product of claim 53, Gerace further discloses that said signal is a transmission over a network (Fig. 1; col 3, lines 50-54).

Claim 55: Gerace, Cullis, Dabney disclose the product of claim 54, Gerace further discloses that said network is the Internet (Fig. 1; col 3, lines 50-54).

5. Claims 10, 22, 34, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Culliss (6,078,916) in view of Dabney (6,643,663).

6. in view of Petty (6,342,907).

Art Unit: 3622

Claim 10, 22, 34, 48: Gerace, Culliss, and Dabney disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39.

Gerace further discloses the utilization of Java and other formats (col 13, lines 51-55) and the utilization of web pages and servers (col 3, lines 54-58; col 1, lines 29-45).

Gerace does not explicitly disclose the utilization of Data Bean or a Java Server Page.

However, Petty implies the utilization of Java Server Pages and discloses the utilization of Data Bean (col 5, lines 20-25; col 9, line 65-col 10, line 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Java Server Pages and Petty's Data Beans to Gerace's utilization of Java, servers, the Internet, and webpages. One would have been motivated to do this in order to provide greater architecture flexibility and platform independence.

Response to Arguments

7. Applicant's arguments with respect to claims 1-55 have been considered but are moot in grounds of the new rejection. Please note the additional citations added to the rejection of the amended claims above.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Also, on page 23 of the Applicant's amendment dated 2/22/05 concerning claims 9, 21, 33, 47, Applicant states that this passage in Gerace does not deal with advertisements, but instead

Art Unit: 3622

deals with agate data. However, please see the independent claim above concerning the relationship between agate data data and advertisement data

Note that Gerace discloses that advertisements can be a form of agate information:

“(18) In accordance with another aspect of the present invention, there are Agate Objects for providing the agate information and a Sponsor Object. In a preferred embodiment, the agate information includes stock information, advertisements, sports statistics, weather reports and the like. With regard to stock information, an Agate Object routine receives stock data on line, parses the data and makes a value-added calculation. As a result, the stock information is made searchable by variables such as price-earnings ratio, and the like” (col 2, line 60-col 3, line 5).

Therefore, any of the functionality in Gerace concerning agata data can also apply to advertising data.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Arthur Duran', with a stylized, cursive script.

Arthur Duran
Patent Examiner
11/23/05